

REMARKS

Claims 18-31 and 33-61 are pending in the above-captioned patent application following this amendment. Claims 1-43 were rejected. Claims 18-25, 27, 29, 31, 33-38 and 43 have been amended, claims 1-17 and 32 have been canceled without prejudice, and claims 44-61 have been added, all for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000), even though the Applicant believes that the previously pending claims were allowable.

Support for the amendments to the claims and for the new claims can be found throughout the originally filed application, including the originally filed claims, the drawings and the specification. More specifically, support for the amendments to the claims and for new claims 44-61 can be found at least in claims 19, 23, 34 and 37, in Figures 1, 5 and 6, and in the specification at page 4, lines 26-29, at page 7, lines 22-34, and at page 8, lines 1-10.

No new matter is believed to have been added by this amendment. Consideration of the Application is respectfully requested.

Interview Summary

On December 17, 2004, the undersigned attorney for the Applicant conducted a telephonic interview with the Examiner, Vishu K. Mendiratta. During the interview, no specific agreement on claim language was reached, although various potentially patentable features of the present invention were discussed in view of the cited references. The Applicant has amended and/or added various claims in view of the interview. The Applicant and the undersigned attorney wish to thank the Examiner for his time and assistance during the interview.

Rejections Under 35 U.S.C. §102

Claims 1-16 are rejected under 35 U.S.C. §102(b) as being anticipated by Van Teunenbroek et al. (US 6,739,935). Claims 1-16 have been canceled without prejudice by this amendment. Therefore, the rejection of claims 1-16 is believed to be moot.

Further, claims 17 and 19 are rejected under 35 U.S.C. §102(b) as being

anticipated by Hennig (US 4,947,527). Claim 17 has been canceled without prejudice by this amendment. Therefore the rejection of claim 17 is believed to be moot. Moreover, the Applicant has amended claim 19 to depend from new claim 48, as provided above. Because new claim 48 is believed to be allowable, a rejection of claim 19 is unsupported by the cited reference, and should be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Van Teunenbroek et al. Further, claims 17-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over a conventional chess game in view of Van Teunenbroek et al. As indicated above, claims 1-17 and 32 have been canceled without prejudice. Therefore the rejection of claims 1-17 and 32 is believed to be moot.

Further, claims 18 and 20-23 have been amended to depend from new claim 44, claims 19, 24, 29 and 31 have been amended to depend from new claim 48, claims 33 and 35-37 have been amended to depend from new claim 56, and claims 34, 38 and 43 have been amended to depend from new claim 58. As provided herein, new claims 44, 48, 56 and 58 are believed to be allowable in view of the cited references. Therefore, claims 18-24, 29, 31, 33-38 and 43 are likewise believed to be allowable. Additionally, claims 25-28 and 30 depend indirectly from new claim 48, and claims 39-42 depend indirectly from claim new 58. Thus, these claims are also believed to be allowable.

New Claims

New claims 44-61 have been added by this amendment. New claims 44-61 are of a slightly different scope than the previously pending claims. However, in view of the cited references, these claims are believed to be allowable.

Hennig is directed toward a coupling system for modular components, such as train sets. The coupling system includes a mounting portion 2 having a male element 10 and a receptacle 12. Each component has a mounting portion 2, with the male element 10 of one mounting portion 2 extending into the receptacle 12 of the other mounting portion 2. However, once two of the components are engaged, no further deformation of the mounting components occurs until the components are disengaged. Stated another

way, the only “deformation” which occurs, if at all, is during the process of becoming engaged, or becoming disengaged. Hennig does not teach or suggest that any deformation occurs while the components are engaged. In addition, Hennig does not teach or suggest that the components of the trains occupy designated positions, or that two such components occupy the same position simultaneously.

The conventional chess game includes pieces that move along a playing surface. However, at no time do two pieces occupy the same position simultaneously. Moreover, even if the Patent Office contends that two pieces do occupy the same position (which the Applicant disputes), a conventional chess game does not teach or suggest any sort of battle or engagement between the two pieces occurring. In fact, the ability of a first piece to move to the square occupied by an opponent’s second piece causes removal of the second piece and replacement of that piece with the first piece. No battle occurs, nor does any deformation to the pieces occur.

Van Teunenbroek et al. is directed toward two break-off keys that can engage, causing permanent damage to one of the pieces. Van Teunenbroek et al. does not teach or suggest using a game board wherein two break-off keys occupy the same position, resulting in engagement and an ensuing battle (or relative movement during engagement between the break-off keys). Further, Van Teunenbroek et al. does not teach engagement of the break-off keys causing temporary deformation of one of the break-off keys. Moreover, Van Teunenbroek et al. does not teach or suggest using a set or team of break-off keys that battle another set or team of break-off keys.

In contrast to the cited references, new claim 44 requires the steps of “moving a first deformable game piece along a playing surface having a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece when the game pieces occupy the same designated position as one another on the playing surface; and moving the engaged game pieces relative to each other to cause a deformation of one of the engaged game pieces.” These steps are not taught or suggested by the cited references. Therefore, claim 44 is believed to be allowable. Because claims 18, 20-23 and 45-47 depend directly or indirectly from claim 44, they are likewise considered to be allowable.

New claim 48 requires the steps of “the first player providing a set of game pieces that includes a first deformable game piece; the second player providing a set of game pieces that includes a second deformable game piece; moving a first deformable game piece along a playing surface having a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece; and moving the engaged game pieces relative to each other to cause a deformation in one of the engaged game pieces.” These steps are not taught or suggested by the cited references. Therefore, claim 48 is believed to be allowable. Because claims 19, 24-31 and 49-55 depend directly or indirectly from claim 48, they are likewise considered to be allowable.

New claim 56 requires the steps of “providing a first break-off key that moves along a playing surface having a plurality of designated positions; providing a second break-off key that moves along the playing surface; engaging the break-off keys when the break-off keys occupy the same designated position as one another on the playing surface; and moving the break-off keys relative to each other to cause a deformation in one of the break-off keys.” These steps are not taught or suggested by the cited references. Therefore, claim 56 is believed to be allowable. Because claims 33, 35-37 and 57 depend directly or indirectly from claim 56, they are likewise considered to be allowable.

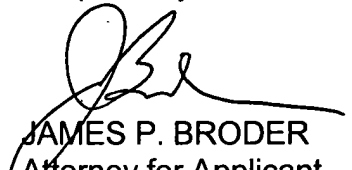
New claim 58 requires “providing a first set of break-off keys including a first break-off key that moves along a playing surface having a plurality of positions; providing a second set of break-off keys including a second break-off key that moves along the playing surface; engaging the break-off keys; and moving the break-off keys relative to each other to cause a deformation in one of the break-off keys.” These steps are not taught or suggested by the cited references. Therefore, claim 58 is believed to be allowable. Because claims 34, 38-43 and 59-61 depend directly or indirectly from claim 58, they are likewise believed to be allowable.

Conclusion

In conclusion, Applicant respectfully asserts that claims 18-31 and 33-61 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-487-4077 for any reason that would advance the instant application to issue.

Dated this 20th day of December, 2004.

Respectfully submitted,



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